

Remarks

A. Overview

The present application includes claims 1-37. With this Amendment Applicants have amended claims 1, 2, 6, 19-21, 23, 25, 27, 29, and 31 and rewritten claims 12, 13, and 17 in independent form. Further, Applicants have added claims 38-57. As such, claims 1-57 are currently pending in this application.

B. Allowable Subject Matter

Applicants acknowledge with appreciation the Examiner's indication that claims 12-17 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

With this Amendment, Applicants have rewritten claims 12, 13 and 17 in independent form. The presentation of claims 12, 13 and 17 in independent form is merely a cosmetic change to original claims 12, 13 and 17 and does not narrow the original scope of claims 12, 13 and 17, respectively. Claims 14-16 still depend from claim 13. Accordingly, Applicants submit that claims 12-17 are in condition for allowance.

C. Declaration

The Examiner indicated that the declaration currently filed in the application is defective because the declaration does not claim the "119(e) benefit for the provisional application 60/064,709." Applicant acknowledges that the current declaration does not reference the above-identified provisional application. However, Applicant respectfully disagrees that the declaration is defective because the reference to the above-identified reference provisional application is not provided.

None of the C.F.R. rules or M.P.E.P. sections cited by the Examiner state that such a reference to a provisional application is required. Further, 37 C.F.R. 1.63 (Oath or Declaration) and M.P.E.P §201.11 (Continuity Between Applications: When Entitled to Filing Date) do not appear to list any requirement to identify in a declaration any identifying information related to a provisional application for which the respective application claims the benefit thereof. M.P.E.P §201.11 does require that the application include a specific reference to the provisional application in either the specification or in an application data sheet. Applicants submit that the current application complies with this requirement.

As such, Applicants submit that the current declaration is proper. If the

Examiner still objects to the declaration as being defective, Applicants respectfully request that the Examiner provide a citation to the applicable rule or M.P.E.P section.

D. Claim Rejections under §102

Claims 1-6 and 23-34 were rejected under 35 U.S.C §102(e) as being anticipated by U.S. Patent No. 6,353,413 to White et al ("White"). The rejected claims include independent claims 1, 23, 27, and 31 from which the remaining rejected claims depend.

White is related to a MULTI-FUNCTION UNIVERSAL CONTROLLER AND LOCATOR SYSTEMS. Referring to Fig. 1, a universal controller (UC) 10 is shown. UC 10 is an integrated remote control unit (including both radio frequency (RF) and infrared (IR) capabilities), a telephone (including cellular telephone and household cordless telephone capabilities), a pager, and a computer terminal for communicating input/output (I/O) data to an intelligent device (e.g., a PDA or PC).

White further discloses two locator systems for determining the location of a target object 124. In both systems, a target object 124 is interrogated to generate a location signal 130 which is received by a plurality of detection units 108. The location of the target object 124 is determined based on measuring the time intervals between a time reference and the times at which a plurality of detection units receive a location signal from the target object 124. In the first locator system 90, the time reference is the instant at which the counters 110 in the base unit 104 are started. In the second locator system 178, the time reference is the instant at which a start-counter signal is issued from the base unit 104 to the detection units 108.

White does not disclose, teach or suggest an integrated device as recited in amended independent claim 1 comprising, "...an infrared transmitter coupled to the controller, the infrared transmitter configured by the controller to transmit an identifying signal on a periodic basis, the identifying signal uniquely identifying the integrated device and a voice recording device coupled to the controller." Applicants respectfully submit that neither the universal controller 10 nor the target object 124 include both the infrared transmitter configured to transmit an identifying signal on a periodic basis and a voice recording device.

For at least these reasons, Applicants submit that the integrated device as recited in independent claim 1 is patentable over White. Accordingly, Applicants submit that independent claim 1 is in condition for allowance.

Claims 2-6 depend from claim 1 and are patentable over White at least for the reasons given above in connection with claim 1 and for the further limitations of claims 2-6. Accordingly, Applicants submit that claims 2-6 are in condition for allowance.

White does not disclose, teach or suggest an integrated device as recited in amended independent claim 23 comprising, "...an infrared transmitter coupled to the controller, the infrared transmitter configured by the controller to transmit an identifying signal on a periodic basis, the identifying signal uniquely identifying the integrated device and a cellular telephone transceiver coupled to the controller." Applicants respectfully submit that neither the universal controller 10 nor the target object 124 include both the infrared transmitter configured to transmit an identifying signal on a periodic basis and a cellular telephone transceiver.

For at least these reasons, Applicants submit that the integrated device as recited in independent claim 23 is patentable over White. Accordingly, Applicants submit that independent claim 23 is in condition for allowance.

Claims 24-26 depend from claim 23 and are patentable over White at least for the reasons given above in connection with claim 23 and for the further limitations of claims 24-26. Accordingly, Applicants submit that claims 24-26 are in condition for allowance.

White does not disclose, teach or suggest an integrated device as recited in amended independent claim 27 comprising, "...an infrared transmitter coupled to the controller, the infrared transmitter configured by the controller to transmit an identifying signal on a periodic basis, the identifying signal uniquely identifying the integrated device and a radio transceiver for two-way communication coupled to the controller." Applicants respectfully submit that neither the universal controller 10 nor the target object 124 include both the infrared transmitter configured to transmit an identifying signal on a periodic basis and a radio transceiver for two-way communication.

For at least these reasons, Applicants submit that the integrated device as recited in independent claim 27 is patentable over White. Accordingly, Applicants submit that independent claim 27 is in condition for allowance.

Claims 28-30 depend from claim 27 and are patentable over White at least for the reasons given above in connection with claim 27 and for the further limitations of claims 28-30. Accordingly, Applicants submit that claims 28-30 are in condition for allowance.

White does not disclose, teach or suggest an integrated device as recited in amended independent claim 31 comprising, "...a paging device coupled to the controller; and an infrared transmitter coupled to the controller, the infrared transmitter configured by the controller to transmit an identifying signal on a periodic basis, the identifying signal uniquely identifying the integrated device." Applicants respectfully submit that neither the universal controller 10 nor the target object 124 include both the infrared transmitter configured to transmit an identifying signal on a periodic basis and a paging device.

For at least these reasons, Applicants submit that the integrated device as recited in independent claim 31 is patentable over White. Accordingly, Applicants submit that independent claim 31 is in condition for allowance.

Claims 32-34 depend from claim 31 and are patentable over White at least for the reasons given above in connection with claim 31 and for the further limitations of claims 32-34. Accordingly, Applicants submit that claims 32-34 are in condition for allowance.

E. Claim Rejections under §103

Claims 35-37 were rejected under 35 U.S.C §103(a) as being obvious over U.S. Patent No. 5,226,090 to Kimura ("Kimura") in view of U.S. Patent No. 5,970,457 to Brant et al ("Brant"). The rejected claims include independent claim 35 from which claims 36 and 37 depend.

To establish a prima facie case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings. However, "[t]he mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Accord, In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992). Also, the prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983); M.P.E.P. § 2141.02.

“[B]oth the suggestion and the reasonable expectation of success must be founded in the prior art, and not in the applicant’s disclosure.” In re Vaeck, 20 USPQ2d 1438, 1442 (Fed. Cir. 1991). “[I]t is the prior art itself, and not the applicant’s achievement, that must establish the obviousness of the combination.” In re Dance, 48 USPQ2d at 1637; Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985).

Further, when combining the content of various references, “there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant.” In re Dance, 48 USPQ2d at 1637; In re Raynes, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); In re Oetiker, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.” In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999); Interconnect Planning Corp., 227 USPQ at 547.

Kimura relates to a VOICE-OPERATED REMOTE CONTROL SYSTEM. Referring to Fig. 6, Kimura discloses a transmitter 1 including a controller 16, a power supply control circuit 14, a microphone M, a speech recognition circuit 15, a transmitting circuit 17, a mode selector switch 13, and a talk switch 12. Based on input from mode selector switch 13, the speech recognition circuit 15 operates in either a speech recognition mode or a speech registration mode.

In the BACKGROUND OF THE INVENTION section, Kimura described the power consumption drawbacks to the continuously energized condition of prior art devices. Specifically, Kimura stated:

In the transmitter of the voice-operated remote control system, a power supply circuit supplies electric energy to the speech recognition LSI circuit, a controller, and other components. In order to process voice commands which may be applied all of a sudden, the speech recognition LSI circuit is normally kept in a standby condition, i.e., remains energized at all times.

If the speech recognition LSI circuit remains energized at all times, then it can also receive other voices than the voices of the operator. As a result, while the AV device is being operated to reproduce recorded sounds, voice signals contained in the reproduced sounds may be entered through the microphone, and the input voice signals may be recognized in error as voice commands, causing an erroneous operation of the AV device.

The speech recognition LSI circuit has a higher power requirement than the usual remote control LSI circuits. Therefore, if the transmitter is battery-powered, it may easily malfunction due to a quick voltage drop

resulting from the power consumption by the speech recognition LSI circuit.¹

In order to overcome these power consumption drawbacks, Kimura states an object of the invention to be “to provide a voice-operated remote control system which has a low power requirement.”² To that end, in the first embodiment disclosed in Kimura (Figs. 4-10),

[T]he transmitter 10 remains in the low power consumption mode and hence in the standby condition unless the talk switch 12 is pressed, as described above, the speech recognition circuit 15 is not energized and no speech recognition process is carried out. As a result, insofar as the talk switch 12 is not pressed, the transmitter 10 is prevented from being triggered into an erroneous operation, and the electric power consumption is reduced,³

and in the second embodiment disclosed in Kimura (Figs. 11-13),

Now, operation of the transmitter 10 will be described below with reference to the flowchart of FIG. 13. It is assumed that the talk switch 12 is not pressed and the transmitter 10 is in the low power consumption mode. ... If the talk switch 12 is not pressed, the transmitter 10 is left in the low power consumption mode, and the steps S102 and S103 are repeated.⁴

Brant relates to a VOICE COMMAND AND CONTROL MEDICAL CARE SYSTEM. Brant discloses a voice command and control medical care system which comprises a processor having a continuous speech recognition capability.⁵ The system is configured to continuously monitor the audio signals such that the operator does not have to speak in a slow, deliberate and unnatural manner.⁶ Brant further discloses the need for eliminating the need to depress or select manual controls. For example, Brant states:

In accordance with the illustrated embodiment, a surgeon 14 or other operator of the voice command and control medical care system 10 can speak verbal commands into a headset 16 while performing surgery The system 10, therefore, eliminates the need to perform certain functions such as manipulating instrument panel controls (indicated generally at 22) manually, thereby allowing the surgeon 14 and any other attending medical personnel 24 freedom to manipulate devices such as hand-held surgical tools and foot pedals and other operating room equipment. The system 10 can reduce burdens placed on a surgeon 14 and other medical attendants 24 during a

¹ Kimura, col. 1, lns. 36-58.

² Kimura, col. 2, lns. 3-5.

³ Kimura, col. 9, lns. 57-65.

⁴ Kimura, col. 11, lns. 5-9.

⁵ Brant, Abstract

⁶ Brant, col. 2, lns. 9-12.

surgical or other medical procedure, and can reduce the number of personnel required in the operating room.⁷

Applicants respectfully submit that the combination of Kimura and Brant used by the Examiner in rejecting independent claim 35 is an improper combination. Regardless of the features of Kimura and Brant, there is no teaching, suggestion or motivation in either Kimura or Brant to combine Kimura and Brant to produce the invention recited in claim 35.

Further, Kimura and Brant each teaches away from the features of the other. For example, as explained above, Kimura attempts to solve various prior art problems associated with power consumption by providing a low power consumption device that requires a talk switch to be depressed to activate the system to respond to voice commands. As such, Kimura requires the activation of a manual control for the system to respond to voice commands which is in direct conflict with the teaching of Brant of eliminating the need to interact with a manual control, such as an instrument panel. Further, the continuous monitoring for voice commands of Brant would require additional power consumption which directly conflicts with at least one of the objects of Kimura. Therefore, one of ordinary skill in the art looking at Kimura and Brant would be dissuaded from modifying Kimura as contemplated by the Examiner.

For at least these reasons, Applicant submits that independent claim 35 patentably defines the invention over Kimura, alone or in combination with Brant. Accordingly, Applicant submits that independent claim 35 is in condition for allowance. Such action is respectfully requested.

Claims 36 and 37 depend from claim 35 and are patentable over Kimura, alone or in combination with Brant, at least for the reasons given above in connection with claim 35 and for the further limitations of claims 36 and 37. Accordingly, Applicants submit that claims 36 and 37 are in condition for allowance.

F. New Claims

With this Response, Applicants have added new claims 38-57. Independent claim 42 is directed to a communication and location tracking system for a facility. Independent claim 55 is directed to a method for paging a staff member. Consideration and allowance of these claims is respectfully requested.

⁷ Brant, col. 3, lns. 39-56.

G. Amendments to the Specification

The proposed amendments to the specification are supported by the current disclosure either explicitly, inherently, or by incorporation of at least one of application serial no. 08/963,396 and application serial no. 08/960,425, both of which are incorporated by reference in the current disclosure (see page 9, lines 17-20).

H. Amendments to the Drawings

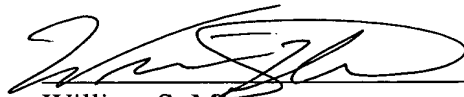
With this response Applicants have added three sheets of drawings including Figs. 11-13. Figs. 11-13 are referred to by the text added in the Amendments to the Specification.

I. Final Remarks

Claims 1-57 are believed to be in condition for allowance. Such allowance is respectfully requested.

If necessary, please consider this a Petition for Extension of Time to effect a timely response. Please charge any additional fees or credits to the account of Bose McKinney & Evans, LLP Deposit Account No. 02-3223. In the event that there are any questions related to these amendments or to the application in general, the undersigned would appreciate the opportunity to address those questions directly in a telephone interview to expedite the prosecution of this application for all concerned.

Respectfully submitted,
BOSE McKINNEY & EVANS, LLP



William S. Meyers
Registration No. 42,884

Indianapolis, Indiana 46204
(317) 684-5273
513736v1